

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated July 9, 2008, (hereinafter Office Action) have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 19, 21, and 23-44 have been canceled without prejudice rendering any rejections of these claims moot. Applicant accordingly reserves the opportunity to pursue the canceled subject matter in a continuing application and requests that any rejections of these claims be withdrawn.

With respect to the objection to the Specification, Applicant respectfully traverses. The objection is based upon the assertion that the Specification does not provide proper antecedent basis for the term “computer-readable storage medium”. First, it is noted that the subject matter of a claim need not be described literally in the Specification (*i.e.*, using the same terms or *in haec verba*) and an applicant is not limited to the nomenclature used in the application as filed. MPEP §§ 608.01(o) and 2163.01. Second, antecedent basis for the now-claimed storage medium is believed to be provided in at least paragraph [0016] of the original Specification. This paragraph discloses that a computer program can be stored in memory means such as a disk, CD-ROM disk or other external data storage media, which would include a computer-readable storage medium. This paragraph has also been amended to remove an interpretation of the claimed storage media as including non-statutory subject matter. Since the Specification discloses storage of a computer program and provides examples of storage media that would constitute statutory subject matter, the Specification is believed to provide proper antecedent basis for the now-claimed storage medium. Applicant accordingly requests that the objection be removed.

With respect to the § 101 rejection of Claims 20 and 22, Applicant respectfully traverses because the claims, as acknowledged by the Office Action, are each directed to a computer-readable data storage medium. Thus, the claimed computer program is structurally and functionally interrelated to the media in accordance with the requirements of MPEP § 2106.01. Consistent with the MPEP, Applicant submits that Claims 20 and 22

are directed to statutory subject matter and accordingly requests that the rejection be withdrawn.

With respect to the § 101 rejection of Claims 10-18, independent Claims 10, 12, and 14 have been amended to recite physical elements of the claims in the bodies of the independent claims. For example, the system of Claim 10 includes a terminal including memory and a server (*see, e.g.*, Fig. 2 and paragraph [0016]); the server of Claim 12 includes at least a processing unit (*see, e.g.*, paragraph [0016]); and the terminal of Claim 14 includes at least a receiver and a processing unit (*see, e.g.*, paragraphs [0015] and [0016]). Since each of these independent claims includes physical structure, an interpretation of the claimed subject matter as software *per se* would be improper.

Applicant respectfully maintains the traversal of each of the prior art rejections ((§§ 102(e) and 103(a)) because U.S. Publication No. 2002/0099727 by Kadyk *et al.* (hereinafter “Kadyk”) fails to teach or suggest each of the claimed limitations. In contrast to the assertion at page fifteen of the Office Action, the asserted notifications of Kadyk do not include settings information comprising settings of at least one database, as claimed in each of the independent claims. Rather, the asserted tokens identify changes made to data being synchronized. Specifically, paragraph [0032] teaches that a token identifies both the data that was changed and the revision of the data that the change represents. Since the tokens merely identify (versions of) synchronized data, *i.e.*, are information of the database content, the tokens relate to the data subject to synchronization and not settings of a database used in initializing a synchronization procedure. Notably, cited paragraph [0054] merely teaches that a server may use its own unique tokens when indicating a change in the data being synchronized (*see*, paragraphs [0047] and [[0032]), and a client simply returns the token receipt during synchronization to the message server instead of processing/using the token. Thus, Kadyk’s tokens are used by a message server to identify data content, which fails to correspond to the claimed settings of at least one database. Without a presentation of correspondence to each of the claimed limitations, the rejections are improper.

Moreover, Applicant further maintains that Kadyk fails to at least teach a configuration message that is transmitted prior to a synchronization procedure, as now explicitly claimed in each of the independent claims. For example, the claims indicate that at least part of the settings information of the transmitted/received configuration message is used to initialize synchronization. In contrast, the asserted update notifications of Kadyk are sent during synchronization, “To synchronize data 282 with data 242, server 210 creates update notifications” (paragraph [0047]). Paragraph [0053] states that “Synchronization begins with the step of a server computer providing notifications (320).” Kadyk’s update notifications are sent as part of a synchronization and the cited tokens are used during synchronization operations (*see, e.g.*, Figs. 3a-b wherein all steps are part of synchronization). Since Kadyk’s update notifications are sent during synchronization any data contained therein would not be used to initialize a synchronization; therefore, the asserted update notifications cannot correspond to the claimed configuration message. Without correspondence to each of the claimed limitations, the prior art rejections are improper.

With particular respect to the § 102(e) rejection, in order to anticipate a claim the asserted reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit also recently held that “Because the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” (*Net Moneyin, Inc. v. Verisign, Inc.*, --- F.3d ----, 2008 WL 4614511 (Fed. Cir. 2008) quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. § 102. Applicant respectfully submits that Kadyk does not teach every element of independent Claims 1, 10, 12, 14, 20, and 22 in the requisite detail, and therefore fails to anticipate Claims 1-3, 5, 10-14, 16, 17, 20, and 22.

Moreover, dependent Claims 2, 3, 5, 11, 13, 16, and 17 depend from independent Claims 1, 10, 12, and 14, respectively, and also stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kadyk. While Applicant does not acquiesce to the particular rejection to these dependent claims, the rejection is also improper for the reasons discussed above in connection with the independent claims. These dependent claims include all of the limitations of their respective independent claims and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2, 3, 5, 11, 13, 16, and 17 is improper. Applicant accordingly requests that the § 102(e) rejection be withdrawn.

Regarding the § 103(a) rejections of dependent Claims 4, 6-9, 15, and 18 based upon Kadyk in view of U.S. Patent No. 6,308,201 to Pivowar *et al.* (hereinafter “Pivowar”), U.S. Patent No. 6,643,669 to Novak *et al.* (hereinafter “Novak”), and U.S. Publication No. 2002/0116500 by Arora *et al.* (hereinafter “Arora”), respectively, Applicant respectfully traverses. As discussed above, Kadyk fails to correspond to the limitations of independent Claims 1 and 14 (from which Claims 4, 6-9, 15, and 18 depend). The further reliance on Pivowar, Novak, and Arora does not overcome the above-discussed deficiencies in the underlying reference. Thus, the asserted combinations of the teachings of Kadyk with Pivowar, Novak, and Arora do not teach each of the claimed limitations of dependent Claims 4, 6-9, 15, and 18, and the rejections should be withdrawn.

It should also be noted that Applicant does not acquiesce to the Examiner’s statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant’s invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner’s characterizations, conclusions, and rejections in future prosecution.

Further, the pending claims have been amended to indicate that the data required for synchronization is settings information. Support for these changes may be found in the original Specification, for example, at paragraphs [0008], [0009], and [0020]; therefore, these changes do not introduce new matter. The claims have also been amended for readability reasons: acronyms have been replaced with the full terminology, the

independent claims have been amended to shorten their respective preambles, and the dependent claims have been amended to maintain antecedent basis. These changes are not made for reasons related to the asserted references, and the claims, with or without these changes, are believed to be patentable over the asserted references for the reasons set forth above.

The Specification has also been amended to address typographical errors. For example, the message identified at page eight, line twenty-five has been changed to be an initialization message consistent with the further discussion in that sentence and portion 305 of Fig. 3. Also, the identified portions of Fig. 3 at page nine, lines six-seven have been changed to read “305 to 306” consistent with the text of boxes 305 and 306 of Fig. 3. These changes are consistent with the original disclosure, do not introduce new matter, and are merely introduced to address typographical errors.

New Claims 45-49 have also been added. These claims largely correspond to original Claims 14-17; therefore, the new claims do not introduce new matter. Each of the new claims is believed to be patentable over the asserted references for the reasons set forth above in connection with the independent claims.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.053PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,  
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